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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,106	04/10/2006	Gino Rapparini	289622US6PCT	9407
22850 7590 09/28/2007 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER SIPOS, JOHN	
			ART UNIT 3721	PAPER NUMBER
			NOTIFICATION DATE 09/28/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/575,106

Applicant(s)

RAPPARINI, GINO

Examiner

John Sipos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-12 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESTRICTION REQUIREMENT

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1,2 and 5-12, drawn to a packaging apparatus, classified in Class 53, subclass 560.

Group II. Claim 13, drawn to a filter pod, classified in Class 206.

The inventions are distinct, each from the other, because of the following reasons:

Inventions I and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product as claimed can be made by another and materially different apparatus, such as one which does not use intermittently rotating wheels but rather a single mold and punch.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

(a) the inventions have acquired a separate status in the art in view of their different classification;

- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is reminded that, upon cancellation of claims to a non-elected invention, the **inventorship must be amended** in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h). Applicant should further **amend the title**, in necessary, to reflect the elected invention.

CONSTRUCTIVE ELECTION

Following is 37 CFR 1.145 which concerns the constructive election of an invention which has previously received an Office action:

"If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention

previously claimed if the amendment is entered, subject to reconsideration and review as provided in 1.143 and 1.144."

Claim 13 is directed to an invention that is independent or distinct from claims 1,2 and 5-12 for the reasons given above.

Since applicant has received an action on the merits for on the invention of Group I, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 13 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP 821.03.

REJECTIONS OF CLAIMS BASED ON FORMAL MATTERS

Claims 1,2 and 5-12 are rejected under **35 U.S.C. ' 112, second paragraph**, as being **indefinite** for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the penultimate line of claim 1, "appropriate" should be deleted and in claims 7,8 and 12 the words "greater" and "deeper" should be amended since all these words need a point of reference to clarify the intended languag.

Claims 10-12 have incorrect dependencies and should be amended as follows to provide antecedence to "holes", "punch", respectively:

- Claim 10 should depend on claim 9; and
 - Claims 11 and 12 and should depend on claim 6; and
-

REJECTIONS OF CLAIMS BASED ON PRIOR ART

Claims 1-3,7&8 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Heist (1,402,293) in view of Schwab (6,662,531). The patent to Heist shows in Figure 8 a packaging machine that comprises a polygonal prismatic wheel 65 with an intermittently horizontal rotating axis 64 and with each flat face of the wheel having at least one recess for forming packs of a specific shape and size. Plunger 53 forms the packaging material into packs of the recess shape. The patent to heist lacks cutting means to cut the web.

The patent to Schwabb shows a packaging machine that comprises a conveyor 13 to feed a web to a cutting means 20 which makes cuts 23 surrounding areas of the web that will form the packs, a piston and mold arrangement 30,31 that forms the recesses in the web in the middle of the previously formed cuts, a filling means 16 and a covering means 41. It would have been obvious to one skilled in the art to provide the machine of Heist with cutting means as shown by Schwabb to make the separation of the web into individual packs more efficient.

Regarding claim 2, the flat faces of the wheel is equipped with dies that may have different shapes and sizes and may be interchanged with different shape and size recesses as discussed on page 2, lines 109-119. Regarding the functional statement of claim 3, each of the faces of the wheel has a plurality of recesses.

Claims 9-12 are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over the patent to Heist (1,402,293) in view of Schwab (6,662,531, as applied above, and further in view of Illy (4,555,894). The Heist and Schwab combination lacks the use of a

tamping punch and suction in the recess. The patent to Illy shows a packaging machine comprising of a conveyor having recesses 24, a punch 45 for forming a pocket in the web by pushing it into the recess, suction channels 25 for holding the web in the conveyor recess, a filling device 4-6 and a tamping punch 47,48 that compacts the product in the web pocket. It would have been obvious to one skilled in the art to provide the Heist machine with suction to hold the web in the recess and with compacting punch to compact the product in the web as shown by Illy to improve the operation of the machine and form more compact packs.

REPLY TO APPLICANT'S ARGUMENTS

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

It should however be noted that the argument that the claimed machine is directed to a machine using paper is of little patentable significance. Since the claims are directed to an apparatus it is the structure of the machine that needs to be patentable over the prior art. The mechanisms being claimed are shown by the combination of references. The use of the machine with paper webs is merely an intended use that may or may not happen depending on what is fed into the machine.

ALLOWABLE SUBJECT MATTER

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **571-272-4468**. The examiner can normally be reached from 6:30 AM to 4:00 PM Monday through Thursday.

The **FAX** number for U.S. Patent and Trademark Office is **(571) 273-8300**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at **571-272-4467**.

**/John Sipos/
Primary Examiner
Art Unit 3721**